

Appl. No. 10/665,539  
Reply dated August 8, 2005  
In Response to Office Action of March 8, 2005

**REMARKS/ARGUMENT**

These remarks are submitted attendant to the filing of a Request for Continued Examination pursuant to 37 C.F.R. § 1.114 and in reply to the Office Action mailed March 8, 2005. In that Office Action, the Examiner rejected claims 1-10 under 35 U.S.C. 102(e) as being anticipated by U.S. Provisional Patent Application, Serial No. 60,438,745 (*Tyler*).

The *Tyler* provisional application was filed January 8, 2003. A corresponding utility application was filed on January 7, 2004, which application was published on July 15, 2004.

THE RULE 131 INVENTOR AFFIDAVITS FILED HEREWITH  
ESTABLISH INVENTION OF THE SUBJECT MATTER  
OF THE REJECTED CLAIMS PRIOR TO  
THE EFFECTIVE DATE OF THE *TYLER* REFERENCE

Pursuant to 37 C.F.R. § 1.131, filed herewith are sworn affidavits from the co-inventors named in the present application, Robert Berghash and Jeffrey L. Frost. In response to the Examiner's 102(e) rejection, Applicants respectfully submit that these affidavits, with supporting exhibits, demonstrate the invention by Applicants of the subject matter disclosed and claimed in the present application before the effective date of the *Tyler* reference, January 8, 2003. More specifically, the attached Rule 131 affidavits establish that the claimed subject matter was conceived of and reduced to practice prior to the effective date of the *Tyler* reference. In addition, because the samples/prototypes developed by Applicants before the effective date of the *Tyler* reference, which embodied the claimed subject matter, were discarded, the attached inventor affidavits also establish that (i) the invention disclosed and claimed in this application

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was conceived of prior to the effective date of the *Tyler* reference, *and* (ii) conception was followed by diligence from a time prior to *Tyler*'s effective date until actual reduction to practice in 2003.

37 C.F.R. § 1.131 provides that the inventor of the subject matter of a rejected claim "may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based." Accordingly, the attached Rule 131 affidavits establish possession of at least the invention falling within independent claim 1 of the present invention. *See In re Tanczyn*, 347 F.2d 830, 146 USPQ 298 (CCPA 1965). Of course, if the subject matter of the independent claim was first invented by Applicants and is allowable, then each of the trailing dependent claims must also be allowable. *See, e.g., In re Fine*, 837 F.2d 1371, 1376, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

A. Conception

The Rule 131 affidavits establish through documentary evidence and exhibits that the invention claimed in the present application was conceived on or before April 17, 2002 (Frost Affidavit ¶¶ 2-8, Exs. A, D). Moreover, the attached exhibits demonstrate much more than the conception of a "vague idea of how to solve a problem." Instead, they prove that a specific embodiment of the invention upon which claim 1 of the present application (the only independent claim) reads was in the inventor's possession by at least April 17, 2002. Specifically, Ex. A to the Affidavit of Jeffrey L. Frost, dated April 17, 2002, discloses and

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describes a hand shield for a hockey stick which included a shield portion with a convex outer surface, and a flexible interior grip connected to the shield portion with an opening to receive a hockey stick. The drawings attached to Ex. A depict a hand shield with a shield portion (referred to as a "cup") having a generally rectangular opening (referred to as a "hole") to accommodate portions of a hockey stick. The drawings further disclose a flexible shield portion with a convex outer surface and an interior grip portion connected to the shield portion which extends away from the shield portion, configured to surround or embrace the hockey stick in a manner which would permit movement of the hand shield up and down the stick. The exhibit, the drawings and the instructions for the drawings clearly show that the flexible shield portion was configured to shield all or part of the user's hand.

B. Reduction to Practice - December 2002

In addition, during the period between July, 2002 and December, 2002, various samples/prototypes of the hand shield were developed, considered and manufactured (Berghash Affidavit ¶¶ 3-11, Exs. D-I; Frost Affidavit ¶¶ 7-8, Ex. E). Samples/prototypes made in December 2002 reflected the design and drawings depicted in Ex. A to Mr. Frost's affidavit, described above. The same design and drawings were sent to Shield Mfg., Applicant Robert Berghash's company, on July 10, 2002 (Ex. D). Thus, the December 2002 samples included a convex flexible shield portion with a generally rectangular opening configured to accommodate a hockey stick, and an inner grip portion attached to the flexible shield portion which extended away from the shield portion, configured so as to slidably embrace a hockey stick. The hand

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shield was designed to shield all or part of a user's hand (*See, Berghash Affidavit ¶ 4*).

C. Diligence/Reduction to Practice

While the samples and prototypes discussed in the affidavits establish conception and reduction to practice of the claimed invention as of December 2002, prior to the effective date of the Tyler reference (*see, Berghash Affidavit ¶ 4*), the inventors did not retain the above-described samples or embodiments. As a result, the inventor affidavits also include facts establishing diligence from the time before January 8, 2003 through the date of reduction to practice of additional samples of which photographs and drawings have been provided. The Affidavit of Robert Berghash, for example, establishes reductions to practice before January 20, 2003, on or about January 31, 2003, as of February 6, 2003, and on August 26, 2003 (Berghash Affidavit ¶¶ 5-8, 11, Exs. D-I, L). Photographs of a sample hand shield produced on or about January 31, 2003 are attached as Ex. H.

There was no period of inactivity. The inventors used reasonable diligence to manufacture samples and prototypes and arrange for the manufacture of an injection mold and the delivery of products covered by the patent claims. After the manufacture of several samples in December 2002 (Berghash Affidavit ¶¶ 4-5, Exs. D-F), the inventors arranged for additional samples to display at a trade show in January 2003 (Berghash Affidavit ¶ 6) and formal drawings in January 2003 (Berghash Affidavit ¶ 7, Exs. G, H). The hand shield displayed at the trade show during the week of January 20, 2003 included a flexible shield portion having a generally a convex outer surface, with an opening to accommodate a hockey stick, and an inner grip portion

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attached to the flexible shield portion which was made to accommodate a hockey stick. (Berghash Affidavit ¶ 6). Further, the photographs attached as Ex. H illustrate a sample of the hand shield produced at that time which included all of the features of at least claims 1-8 of the present application.

Immediately thereafter, in February, quotations were sought from vendors to manufacture an injection mold to produce large quantities of the claimed hand shield (Berghash Affidavit ¶ 9, Ex. J). On April 25, 2003, an injection mold was ordered together with an initial order of hand shields, and the first hand shield was shipped on August 26, 2003 Berghash Affidavit ¶ 11, Exs. K, L; Frost Affidavit ¶ 10).

Finally, this application was filed on September 19, 2003.

Due to the nature and design of the claimed invention, test results were not required to establish the utility of the subject matter in question. The samples detailed in the attached affidavits and exhibits established its utility. Each of the various samples discussed and described in the inventor affidavits were sufficient to practice the invention, as well as the final product which was ultimately offered for sale. Both inventors are United States citizens and, as can be seen from the exhibits attached to the inventor affidavits, all actions described therein were taken in the United States.

Based on the foregoing, and the Rule 131 inventor affidavits filed herewith, Applicants respectfully submit that they have conclusively established that the Applicants invented the

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claimed invention before the effective date of the *Tyler* reference. Formal allowance of claims 1–10 is therefore courteously solicited.

SEVERAL ASPECTS OF THE CLAIMED INVENTION  
ARE NOT DISCLOSED IN *TYLER*

*Tyler* does not disclose an interior grip portion (referred to in *Tyler* as an “inner sleeve member”) comprising a plurality of generally parallel flexible tabs, as in claim 3 of the instant application. *Tyler* discloses a one-piece cylindrical inner sleeve or, alternatively, a one-piece generally rectangular inner sleeve (*Tyler* ¶¶ [0010], [0012]). The present application discloses, in a preferred embodiment, a total of four separate tabs through which a hockey stick may be passed. (Application ¶ [0020]; Fig. 3, 4).

In addition, *Tyler* does not disclose an opening in the hand shield configured so as to accommodate multiple cross-sectional configurations of a hockey stick, as in claims 5 and 6 of the present application. In the preferred embodiment illustrated in Fig. 2 of the present application, a hand shield having an “outwardly rounded center portion which provides greater flexibility and/or accommodates hockey sticks with, among other things, round or oval cross-sections.” (Application ¶ [0019]). In addition, the preferred embodiment discloses an opening extending generally outwardly from the four corners of the generally rectangular opening “to provide additional flexibility and to allow for hockey sticks of various shapes and sizes to pass through the opening. . .” (*Id.*) This embodiment also permits the use of a hockey stick having a fixed butt end, as claimed in claim 7.

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These remarks are believed to be fully responsive to the Office Action mailed March 8, 2005, and are believed to materially advance prosecution of this Application toward immediate allowance. Formal allowance of claims 1-10 is therefore courteously solicited.

Respectfully submitted,

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CERTIFICATE OF MAILING

I certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, this 8th day of August, 2005.

PHILLIPS LYTLE LLP

By   
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Signed: December 16, 2004

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